

REMARKS

Three new dependent claims 26 to 28 have been added specifying that the lubricant is present in the acrylic resin in an amount of about 0.1 to about 10% by weight; the new claims depend respectively from independent claims 13, 17, and 21 and are supported by the disclosure at page 8, lines 22 to 25 of the specification.

Claims 13, 14, 17, 18, and 21 to 25 were rejected in the Final Rejection mailed November 14, 2003 under the first paragraph of 35 USC 112 for alleged lack of enablement. It was stated at page 2 of the Final Rejection that "the instant disclosure at the time of filing does not provide any method by which this kinetic friction range is obtained" but the specification indeed does show such a method. The Examiner is directed to the paragraph bridging pages 4 and 5 of the specification, which absolutely and completely explains how the coefficient of kinetic fiction is measured for this invention. The specification, moreover, at page 5, lines 7 to 18, explains why the coefficient of kinetic friction should be between 0.2 and 0.9 when measured by the method described in the paragraph bridging pages 4 and 5. The Examiner is also directed to page

14, lines 21 to 33 and more particularly to lines 30 to 33 wherein it is stated that the sample sheets (A to D) "were subjected to the measurement of coefficient of kinetic friction with respect to a flat glass plate." The results thereof appear in Table 2 on page 16. The specification is enabling and the person of ordinary skill in the art would have no difficulty in practicing the invention.

The Examiner has given no reason by reference to authority why it is necessary to have a particular designation of surface roughness or type of flat glass plate to determine the coefficient of kinetic friction here. What is missing from the disclosure of the method in the paragraph bridging pages 4 and 5 that would prevent such measurements to be made?

The Examiner also states in the sentence bridging pages 2 and 3 of the Office Action, "In terms of the state of the art, typically when citing a coefficient of kinetic friction one skilled in the art usually refers to the value obtained between two substrates of the same inventive material or one inventive substrate versus a standard substrate or material using a standard method or a described method." The Examiner has not explained why the method adequately disclosed in the application

in the paragraph bridging pages 4 and 5 is not a proper method for determining the coefficient of kinetic friction in this context. The technique described there is readily understandable. One places an acrylic resin sheet on a flat glass plate, then places a gauze-wrapped square plate of certain dimensions on the acrylic resin sheet, then places a 10 g weight on the plate, and measures tensile force under specified conditions. The measurement step is repeated 5 times; the mean value is then divided by the weight of the weight to determine the coefficient of kinetic friction.

The Examiner has also asserted that no working examples have been provided for one of skill in the art. The specification does contain working examples as indicated above; see pages 14 to 17 of the specification.

The Examiner states in the Response to Arguments section of the Office Action that the portions of the specification mentioned in the Request for Reconsideration filed September 4, 2003 (and also mentioned above) "provide a general description of the method utilized to test the friction coefficient," a comment that seems to be at odds with the previous noted assertion in the Office Action that there is no disclosed method

in the specification for such measurements. The method described in the paragraph bridging 4 and 5 is a specific one; specific values are mentioned and the description is anything but a "general" one.

The Examiner also suggests that the type of flat glass plate, flatness or roughness thereof also are essential to what is required for such a measuring technique. These are assertions unsupported by any reference to authority. The Examiner has not shown to date why a conventional flat glass plate, accepting for the moment there can be variations therein, would not allow a person of ordinary skill in the art to undertake the measurements required (and properly described) here. Applicant points out also that the coefficient of kinetic friction recited in the claims is a measure of the amount of lubricant in the acrylic resin. Thus, glass plate surface roughness is of little or no consequence as long as the same glass plate is used for the coefficient of kinetic friction value determinations, a practice that should be self-evident.

Applicant lastly points out that the coefficient of kinetic friction range and the mention of a flat glass plate appear in the claims of parent 6,001,292. No issue was raised during the

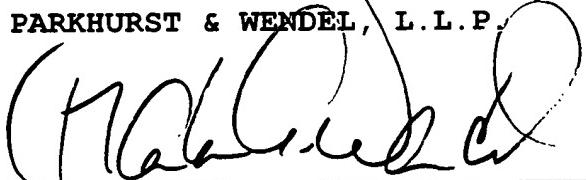
Serial No. 09/397,034

prosecution of that case about the manner of determining the coefficient of kinetic friction. See Ex parte Hampton, 35 USPQ 169 (Bd. App. 1937) pointing out that the agency should not be casting a cloud on an issued patent by criticizing language in a pending related case that appears in the patent.

Reconsideration of the application is earnestly solicited.

Respectfully submitted,

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May 7, 2004  
Date

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Attorney Docket No.: DAIN:435A

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